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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/762,104  
Filing Date: January 20, 2004  
Appellant(s): GAUTHIER ET AL.

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Richard Getz  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10/29/2008 appealing from the Office action mailed 06/11/2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct (although the numbering of headings are out of order, no rejections are missing). The changes are as follows: Erroneous citing of US 5,534,237 to Nishi et al. should be US 5,534,327 to Nishi et al. and thus will be referred as the correct number hereafter.

**WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner: All rejections using USPN 1,672,537 to Novak (Claims 1-3, and 5 over US 6,440,538 to Ungar in view of US 1,672,537 to Novak).

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

3,700,537	H.I. SCHER	10-1972
6,440,538	UNGAR	08-2002
5,811,122	SCHLUP ET AL.	09-1998
5,344,692	SCHMOOCK	09-1994
5,534,327	NISHI ET AL.	07-1996
4,132,821	HIERS ET AL.	01-1979
7,179,538	GAUTHIER ET AL.	02-2007
6,558,799	TAKEUCHI ET AL	05-2003

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference

claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/762,103 in view of Scher. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application contain the subject matter that is narrower in scope than that in the instant claims, rendering them obvious over each other. Further a difference between using phenolic or melamine based formaldehyde impregnates are taught by Scher at 5:15-25 to be suitable for using in paper or cellulosic based papers, thus choosing one over the other would have been an obvious choice for creating a decorative laminate.

This is a provisional obviousness-type double patenting rejection.

Claims 1-9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 7,179,538 whether alone, or in view of Hiers et al. (US Pat. 4,132,821).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the patented claims is narrower than that of the instant claims, rendering them obvious over each other.

In regards to instant claims 1-9, the patent contains all the limitations in the instant claims, despite a wording of backing layer vs. substrate, they have the same meaning. However, the patented independent claims 1, 2, and 3 include the flexible backing layer in addition to the leather layer and the decorative layer of instant claim 1, and the backing is considered equivalent to the instant substrate. Thus, the scope of the instant claims embraces that of the patented claims, rendering them obvious over each other.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,440,538 to Ungar in view of US 5,534,327 to Nishi et al.

2. Ungar teaches an abrasion resistant laminate wherein a ware resistant upper layer is made under high pressure and temperature (4:35-45), the first wear layer 6 (shown in Fig. 2, laminated and apart of 12 of Fig. 3) may be made according to Lane or Mehta (6:23-35) using impregnated paper (5:35-40) or produce a melamine (resin) saturated paper (embraces impregnated) (6:35-40) or produce a melamine impregnated alpha cellulose or paper sheet (6:45-50). Further the decorative layer 7 under wear layer 6 is also impregnated with melamine resin (6:60-68) as is the core layer 8 (all layers 6, 7, and 8 represent an overlayer, underlayer, substrate, and backer as claimed). Both layers 7 and 8 are also of paper (embraces cellulose, see 7:1-45). At least four impregnated paper layers are used (see also Fig. 6, layers 8A-8D illustrating four for the core and where a total of six possible impregnated paper layers are employed—equating to instant claim 6 use of first and second decorative and underlayers) and the wear layer is decorative (see Abstract). See also the additional functionality of layer 6 also being an overlay to protect the decorative layer 7 (6:47-55). Claims 1, 3, 5 are addressed.

3. Ungar does not teach a decorative layer consisting essential of a leather material.

4. Nishi teaches a powdered leather comprised of at least 85% natural raw leather hide, which can be used and manufactured into a thin film, molded products, coatings or fibers (1:19-35, 2:5-40) and in general, laminates (10:1-68, 11:1-25, maximum 60% of natural raw leather powder, equivalent in meaning to decorative layer consisting essentially of leather material).

The laminate uses the leather in the pores of the outermost skin layer, intermediate and substrate layers, where the substrate may be cloth, film, or paper. The leather contained products resultant therefrom the laminate exhibit good touch, and grip material having tactile quality (same reasons as Applicant).

5. It would have been obvious to one having ordinary skill in the art to have modified the printed paper wear layer of Ungar to use, incorporate, or substitute an improved paper leather material. Because Ungar was also concerned with abrasion resistance (see the title), it would have been expected that the incorporation of leather material. Additionally, it would have been obvious to one having ordinary skill in the art to have modified Ungar also to include decorative leather material for Nishi's reasons such as good touch, and grip material having tactile quality.

6. Applicant is directed to the following note to the inclusion of leather material: Though we are fully cognizant of the hindsight bias that often plagues determinations of obviousness, Graham v. John Deere Co., 383 U.S. 1, 36 (1966), we are also mindful that "the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results," KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739 (2007). Thus, it is not a stretch to envisage leather material in a high pressure laminate as one having skill would expect leather material to aim at the purpose of making it feel soft-to-the-touch. It is well known that leather feels soft.

7. Also note to these points above regarding using leather material: Motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *In re Hoeschele*, 406 F.2d 1403, 1406-407, 160 USPQ 809, 811-12 (CCPA 1969).



Regarding the thickness recitation per instant claim 2 the combination does not teach. However, it is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980). Thickness effects durability and strength.

The references above do not teach a migrated resin from the underlying, however, since thermosetting resins are impregnated in the same fashion and in the same order, this transition is expected (claim 1).

8. Claims 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,440,538 to Ungar in view of US 5,534,327 to Nishi et al. and further in view of Nelson (US 6324809).

9. The combinations are applied above.

10. The combinations do not teach a substrate of plywood or particle board or medium density per instant claim 4.

11. Nelson teaches a similar laminate flooring having a decorative surface of conventional high pressure decorative laminate made from melamine formaldehyde impregnated paper attached to a core via adhesives, wherein the core is of wood based products such as high density fiberboard, polyvinyl chloride (equivalent core material to that used by Ungar), and veneers (embraces plywood) at 3:1-50. See also 5:30-35 and Abstract.

12. It would have been obvious to one having ordinary skill in the art to have modified the combination to substitute, use, or incorporate plywood, particle board, or fiber board because Nelson teaches said wood based materials are equivalent to polyvinyl chloride used as cores for decorative melamine impregnated paper surface layers in laminate flooring as cited above.

13. Claims 1-3, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scher (US 3,700,537) in view of Schlup et al. (US 5,811,122 ) or alternatively in view of Schmoock (US 5,344,692) or alternatively in view of Hiers et al. (US 4,132,821) or alternatively in view of US 5,534,327 to Nishi et al.

Scher teaches in this order: overlay 20, Fig. 3A and associated text (overlayer), embedment sheet 18, Fig. 3A and associated text (function as decorative layer), print sheet 16, Fig. 3A and associated text (one or more cellulosic sheet impregnated with melamine-formaldehyde resin, functioning as underlay layer), core sheet 14 (top layers), Fig. 3A and associated text (one or more cellulosic sheet impregnated with melamine-formaldehyde resin, function as substrate), core layer 14, (bottom ones) (cellulosic impregnated with the same aforementioned resin - backer layer), and plate 12, Fig. 3A and associated text (second decorative layer of any dimensionally stable material). Claims 1-3, and 5 are addressed.

Scher does not expressly disclose said layers are of a leather material nor a bonded leather (instant claim 1-2), while using it in a laminated composite simulating leather.

However, Scher teaches embedment layer being of almost of any construction (5:35-38), so long as it doesn't melt during lamination (5:50-55).

Schlup teaches a similar leather/polymer composite material used in structural composite (4:39-40) materials to improve hide/leather properties with impregnated polymer systems, such composite material improves several properties surrounding those effected by heat and pressure, namely toughness, machinability, elasticity, compressibility and sealing where Schlup teaches the necessity of such an improvement in the hide and leather industries and laminated composites. See 1:10-20, 2:30-65, patented claims 1-15, Example 2, and Tables 1-2. Such description of this material is considered equivalent to Applicant's claimed leather or bonded leather materials. Schlup also teaches pressure and heat applications of up to 160 degrees C and 3.8 psig in a hot press (4:15-18, 8:7-25, Tables 1-2 show all properties of using hide/leather alone and with a polymer). Such heat and pressure teachings in conjunction with teachings of use in structural composites serve to produce a similar heat and pressure consolidated laminate like that of Scher.

Schmoock teaches a leather-containing composite material used in structural composite materials in application of heat and/or pressure as a low-cost alternative (Abstract, 3:1-40). Such description of this material is considered equivalent to Applicant's claimed leather or bonded leather materials.

Hiers discloses the use of leather containing animal hides (see 1:6-9) for the hand and feel of natural leather (Abstract) in a non-woven composite (patented claims 1-2) (which is the same reason Applicant uses the leather material) under a hot press enduring heat and pressures of 225 to 500 degrees F and 5 to 500 lbs per sq. in. (see 12:20-30, Example 1, especially lines 45-50 of col. 13).

14. Nishi teaches a powdered leather comprised of at least 85% natural raw leather hide, which can be used and manufactured into a thin film, molded products, coatings or fibers (1:19-35, 2:5-40) and in general, laminates (10:1-68, 11:1-25, maximum 60% of natural raw leather powder, equivalent in meaning to decorative layer consisting essentially of leather material). The laminate uses the leather in the outermost skin layer, intermediate and substrate layers, where the substrate may be cloth, film, or paper. The leather contained products resultant therefrom the laminate exhibit good touch, and grip material having tactile quality (same reasons as Applicant).

It would have been obvious to one having ordinary skill in the art to have modified the composite of Scher to use the leather composite material of Schlup for the purpose of improving several properties surrounding those effected by heat and pressure, namely toughness, machinability, compressibility and sealing where the such an improvement in laminated composites is needed in the hide and leather industries as taught by Schlup (1:10-20, 2:30-40, patented claims 1-15, Example 2, and Tables 1-2).

It would have been obvious to one having ordinary skill in the art to have modified the composite of Scher to use the leather composite material of Schmooch for the purpose of improving several properties surrounding those effected by heat and pressure where such an improvement in laminated composites is a low cost alternative to high-quality leathers as taught by Schmooch (3:1-45, Abstract).

It would have been obvious to one of ordinary skill in the art to have employed leather comprising animal hides as taught by Hiers in the woven or cloth embedment layer of the laminate of Scher because leather containing animal hides as well as simulated leather have been

conventionally used in the art of decorative articles for the hand and feel of natural leather in a non-woven heat and pressure composite, which is the same reason Applicant uses the leather material as cited above.

Additionally, it would have been obvious to one having ordinary skill in the art to have modified Scher also to include decorative leather material for Nishi's reasons such as good touch, and grip material having tactile quality.

Applicant is directed to the following note to the inclusion of leather material: Though we are fully cognizant of the hindsight bias that often plagues determinations of obviousness, Graham v. John Deere Co., 383 U.S. 1, 36 (1966), we are also mindful that "the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results," KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739 (2007). Thus, it is not a stretch to envisage leather material in a high pressure laminate as one having skill would expect leather material to aim at the purpose of making it feel soft-to-the-touch. It is well known that leather feels soft.

Also note to these points above regarding using leather material: Motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *In re Hoeschele*, 406 F.2d 1403, 1406-407, 160 USPQ 809, 811-12 (CCPA 1969).

Regarding the thickness recitation per instant claim 2, Scher does not teach. However, it is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980).

The references above do not teach a migrated resin from the underlayer, however, since thermosetting resins are impregnated in the same fashion, this transition is expected (claim 1).

15. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scher in view of Schlup et al. or alternatively in view of Schmook (US 5,344,692) or alternatively in view of Hiers et al. (US 4,132,821) or alternatively in view of US 5,534,327 to Nishi et al.

Scher teaches in this order: overlay 20, Fig. 3A and associated text (overlayer), embedment sheet 18, Fig. 3A and associated text (function as decorative layer), print sheet 16, Fig. 3A and associated text (one or more cellulosic sheet impregnated with melamine-formaldehyde resin, functioning as underlay layer), core sheet 14 (top layers), Fig. 3A and associated text (one or more cellulosic sheet impregnated with melamine-formaldehyde resin, function as substrate), core layer 14, (bottom ones) (cellulosic impregnated with the same aforementioned resin - backer layer), and plate 12, Fig. 3A and associated text (second decorative layer of any dimensionally stable material). Claims 6 and 8 are addressed.

Scher teaches embedment layer being of almost of any construction (5:35-38), so long as it doesn't melt during lamination (5:50-55).

Scher does not expressly disclose said layer is of a leather material nor a bonded leather (instant claim 6-7), while using it in a laminated composite simulating leather. Scher does not expressly repeat the layers 20 and 18 to produce a second decorative and second underlayer, however, unless the reference teaches away from reproducing said layers, it is obvious to provide a second combination of decorative layer adjacent a second underlayer motivated by the desire of providing more stability or thickness to the overall structure, as Scher suggests any construction may be the embedment layer, it would have been obvious to be said second layers, especially since the embedment layer is surrounded by one or more cellulosic resin impregnated sheets. Additionally, the mere duplication of parts has no patentable significance unless a new and unexpected result is produced.

Schlup teaches a leather/polymer composite material used in structural composite materials to improve hide/leather properties with impregnated polymer systems, such composite material improves several properties surrounding those effected by heat and pressure, namely toughness, machinability, compressibility and sealing where Schlup teaches the necessity of such an improvement in the hide and leather industries and laminated composites. See 1:10-20, 2:30-40, patented claims 1-15, Example 2, and Tables 1-2. Such description of this material is considered equivalent to Applicant's claimed leather or bonded leather materials.

Schmoock teaches a leather-containing composite material used in structural composite materials in application of heat and/or pressure as a low-cost alternative (Abstract, 3:1-40). Such

description of this material is considered equivalent to Applicant's claimed leather or bonded leather materials.

Hiers discloses the use of leather containing animal hides (see 1:6-9) for the hand and feel of natural leather (Abstract) in a non-woven composite (patented claims 1-2) (which is the same reason Applicant uses the leather material) under a hot press enduring heat and pressures of 225 to 500 degrees F and 5 to 500 lbs per sq. in. (see 12:20-30, Example 1, especially lines 45-50 of col. 13).

16. Nishi teaches a powdered leather comprised of at least 85% natural raw leather hide, which can be used and manufactured into a thin film, molded products, coatings or fibers (1:19-35, 2:5-40) and in general, laminates (10:1-68, 11:1-25, maximum 60% of natural raw leather powder, equivalent in meaning to decorative layer consisting essentially of leather material). The laminate uses the leather in the outermost skin layer, intermediate and substrate layers, where the substrate may be cloth, film, or paper. The leather contained products resultant therefrom the laminate exhibit good touch, and grip material having tactile quality (same reasons as Applicant).

It would have been obvious to one having ordinary skill in the art to have modified the composite of Scher to use the leather composite material of Schlup for the purpose of improving several properties surrounding those effected by heat and pressure, namely toughness, machinability, compressibility and sealing where the such an improvement in laminated composites is needed in the hide and leather industries as taught by Schlup (1:10-20, 2:30-40, patented claims 1-15, Example 2, and Tables 1-2).



It would have been obvious to one having ordinary skill in the art to have modified the composite of Scher to use the leather composite material of Schmooch for the purpose of improving several properties surrounding those effected by heat and pressure where such an improvement in laminated composites is a low cost alternative to high-quality leathers as taught by Schmooch (3:1-45, Abstract).

It would have been obvious to one of ordinary skill in the art to have employed leather comprising animal hides as taught by Hiers in the woven or cloth embedment layer of the laminate of Scher because leather containing animal hides as well as simulated leather have been conventionally used in the art of decorative articles for the hand and feel of natural leather in a non-woven heat and pressure composite, which is the same reason Applicant uses the leather material as cited above.

Additionally, it would have been obvious to one having ordinary skill in the art to have modified Scher also to include decorative leather material for Nishi's reasons such as good touch, and grip material having tactile quality.

Applicant is directed to the following note to the inclusion of leather material: Though we are fully cognizant of the hindsight bias that often plagues determinations of obviousness, Graham v. John Deere Co., 383 U.S. 1, 36 (1966), we are also mindful that "the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results," KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739 (2007). Thus, it is not a stretch to envisage leather material in a high pressure laminate as one having skill would expect leather material to aim at the purpose of making it feel soft-to-the-touch. It is well known that leather feels soft.

Also note to these points above regarding using leather material: Motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness “from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.” *In re Hoeschele*, 406 F.2d 1403, 1406-407, 160 USPQ 809, 811-12 (CCPA 1969).

Regarding the thickness recitation per instant claim 7, Scher does not teach. However, it is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980).

The references above do not teach a migrated resin from the underlyer, however, since thermosetting resins are impregnated in the same fashion, this transition is expected.

17. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scher in view of Schlup or Schmooch or Hiers et al. or Nishi, as applied to claims 1 and 6 above, and further in view of Takeuchi et al.

The combination is relied upon above.

The combination is silent to a substrate of materials listed in claims 4 and 9.

Takeuchi teaches a decorative composite where the substrate is of a variety of materials, including that of Scher, paper and cellulosic sheet materials, and also all those listed in claims 4 and 9 (5:10-61), thereby teaching equivalent materials used for the same supportive purpose as a substrate applied in composites.

It would have been obvious to one having ordinary skill in the art to have modified the composite of the combinations to use plywood, medium density fiberboard, or particleboard because Takeuchi teaches they are equivalents to cellulosic sheets used as a substrate for composites (Takeuchi, 5:10-61, 12, Abstract).

#### **(10) Response to Argument**

- Applicant argues the **Obviousness Double Patenting** rejections. Applicant argues a premature determination, however, this is a provisional rejection. Applicant argues a backing layer in '538 Patent is distinct, however, there are backing layers in the instant claim (backer is the same as backing). Applicant argues the term "flexible" is left out of the instant claims while in the '538 patent cited in full above. However, this is not convincing because flexibility is an obvious feature as it is a property and the instant claims are more broad, which read on the more narrow patented claims.
- **Applicant argues Ugar in view of Nishi:** Nishi provides a natural leather raw material used in over 50 wt. % in a variety of composites, materials, and fibers, should Applicant have support for using over 50 wt% and/or showing a deleterious effect. Applicant has not made convincing arguments while pointing

out Nishi teaching more than 90% powdered leather and discloses the binder in 99 to 10% resin would affect the powdered leather. However, Applicant's specification on page, 3 [0004] states specifically that the leather material is bonded leather including a resin/bonding agent, in the same way of Nishi, and is commercially available: "The decorative layer includes a leather material. The "leather" referred to herein is an animal hide and is not limited to any particular type of animal. Preferably, the leather material is bonded leather. The term "bonded leather" as used herein refers to a leather product that comprises leather shavings made from scrap and/or recycled leather. The shavings are processed into a sheet product using bonding agents. Bonded leather is commercially available and will not, therefore, be further described herein. Although leather with an embossed finished surface can be used, it is preferable to use leather that initially has a smooth surface." Thus as Applicant specification clearly discusses bonded leather including resin, resin would not materially affect the invention deleteriously. Nishi shows the use of leather material is consistent and in the same way as claimed and explained in the specification. Thus the resin is perfectly within reasonable interpretation showing the same level of deference to Nishi and does not teach away as alleged.

- **Applicant argues Scher in view of Schlup**, in that since Scher teaches a less expensive look than with leather, then Scher doesn't teach motivation for substituting a natural material such as leather as set forth above. However, Applicant has not claimed a natural leather, but a leather material. Thus Applicant

has not limited the claims to only natural leather. The term "leather material" is broadly interpreted. Moreover, Scher teaches at 5:35-38 the embedment layer being of almost any construction, non-critical, and would not be destroyed during lamination. Thus a leather material is one of those constructions not far from the instant claims to yield improvements in toughness and compressibility, which the primary reference Scher was concerned. Applicant argues Schlup doesn't teach high pressure laminates, however, this reference is not used to teach that as the primary reference Scher teaches that and further the temperatures of Schlup are over 200 degrees, so that is considered high temperature (see col. 2, line 64) and Examples 3 and see Example 4 up to 3.8 psig for 1 hour, which is considered high pressure. Schlup teaches the laminate is for structural composite materials (col. 2, line 40). The impregnation description found at col. 9, lines 40-col. 10, line 35, explain the leather has void spaces between the fibers (thus porous) so that the resin may be fully impregnated. This description is in line with the purpose of the primary reference whose embedment layer 18 is porous also and made that way to absorb resin (and thus impregnation occurs). Leather material would inherently have the feel, smell and touch of leather, because said material is made from leather (answer regarding that Scher nor Schlup provide such desirable qualities). Applicant argues the leather decorative layer is not fully impregnated (which is not claimed). However, the same materials are used in the same layers and thus migration as explained above would naturally flow at some point in time before it is cured, despite Applicant's allegations that a combination would not suggested

and would teach away because Scher teaches fully cured and fully impregnated laminates.

- Applicant argues Scher's expenses; however, expenses are not of issue when the motivation is found in the leather material having the same elements.
- Applicant argues other in situ polymerization techniques; however this is not claimed and not relevant to the instant claims.
- Applicant argues Schlup provides no reason to include a decorative layer as claimed, however, for reasons set forth above, the combination is proper. Scher is not limited to the type of embedment layer material it may constitute (i.e. "almost any construction", "the material from which the embedment 18 is formed is non-critical"-5:35-55, Scher). While it is a preference for porous material, such as paper or cloth so it can absorb resin, paper and cloth is a preference and porous material in general is taught. Thus, porous leather impregnated with resin such as Schlup is the very substitution Scher suggests and is therefore a suitable substitute for a prima facie case of obviousness. The teaching of Scher thus does not have to show a single embodiment in which every element is included, but must be sufficiently specific disclosure to place the invention in view of one having ordinary skill in the art. See MPEP 2123: Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Furthermore, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such

disclosure does not criticize, discredit, or otherwise discourage the solution claimed....” In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

- Applicant argues the teaching of Scher is contradictory in that a leather would not need a print. However, this has not been proven. Scher teaches a print 16, and is further speculative and thus does not teach away from combining the references.
- Applicant argues the need and utility of the Scher and Schlup combination pointing to leather again, which is not claimed.
- **Applicant argues Schmook**, alleging no impregnated resin or bonded leather substrate or high pressure laminate (HPL) is taught. However, this reference is not used to teach that as the primary reference Scher teaches HPLs. Moreover, Schmook explicitly teaches heat and pressure applications in the Abstract and 3:1-40, which is equivalent in meaning to HPLs, which are the same laminates as Scher. Schmook teaches the improved flexible laminate is obtained whose outside appearance is that of leather and the substrate consists of leather which may also be applied to paper. See 3:1-55, Abstract, Schmook. Scher does not teach away from using a leather decorative sheet, despite if one thinks it is expensive, namely because Applicant's claims are directed to leather material. Cost is not a factor when it is an obvious substitution. For the reasons above, Scher does not teach away from the use of a decorative layer including leather material (despite Applicant's allegations to the contrary and incorrectly construing the claims to mean a leather decorative layer).

- **Applicant argues Scher in view of Hiers**, alleging Hiers teaches an object of artificial leather, however, this still reads on "a leather material" as Applicant has not limited the claims to solely raw leather, if that is what Applicant intends. Moreover, as consistent with the specification (see [0004] above), the meaning found in Hiers is construed with the definition outlined therein. Further Hiers teaches it is well known to use natural as well as artificial leather for the feel and touch, the same as Applicant, and thus does not only teach artificial type. As Scher primarily suggests, a porous open weave woven fabric material as the embedment layer 18 (5:43-44), and thus the leather material of Hiers is the same construction-- a suitable non-woven leather textile (embraces porous open weave woven fabric). Applicant is directed to the following note: Though we are fully cognizant of the hindsight bias that often plagues determinations of obviousness, Graham v. John Deere Co., 383 U.S. 1, 36 (1966), we are also mindful that "the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results," KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739 (2007). Thus, it is not a stretch to envisage leather material in a high pressure laminate as one having skill would expect leather material to aim at the purpose of making it feel soft-to-the-touch. It is well known that leather feels soft.
- Also note to these points above regarding using leather material: Analysis of whether the subject matter of a claim would have been obvious need not seek out precise teachings directed to the specific subject matter of the challenged claim,



for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-741, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336-37 (Fed. Cir. 2006)). It is proper to take into account not only specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom..." The analysis supporting obviousness, however, should be made explicit and should "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements" in the manner claimed. *KSR*, 127 S. Ct. at 1739, 82 USPQ2d at 1396. Motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *In re Hoeschele*, 406 F.2d 1403, 1406-407, 160 USPQ 809, 811-12 (CCPA 1969).

- **In regards to Scher in view of Nishi**, Applicant's arguments are not convincing as Nishi as set forth above, is reasonable to combine with the general embedment layer 18 of Scher. Nishi teaches a non-woven cloth in which the resin and powdered leather are impregnated (11:1-25, Nishi), thus because this is the same

porous open weave fabric as Scher suggests, it is clear motivation to add something similar with the additional advantages of leather such as a good touch, leather-like grip, and improved durability (2:8-11, Nishi), especially due to the use of a paper substrate (10:10, Nishi), the same substrate of Scher. Thus in combination, it is expected to successfully work.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Tamra L. Dicus/

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